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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,920	03/15/2004	Howard Sosin	2002832-0041	9565
24280	7590	07/23/2004	EXAMINER	
Choate, Hall & Stewart			EVANISKO, LESLIE J	
Exchange Place			ART UNIT	
53 State Street			PAPER NUMBER	
Boston, MA 02109			2854	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/800,920	Applicant(s) SOSIN, HOWARD <i>OK</i>	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2004-03-15</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to properly further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, note the ball is not part of the claimed ball marking device of claim 1, and therefore whether the ball has markings on it prior to being marked by the marking device is of no patentable significance to the claimed apparatus.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 19, and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Beny et al. (US 4,546,644). Beny et al. teach a marking device and method comprising a marking device **10, 46** for marking a putting directional indicator on the dynamic axis of the ball

Art Unit: 2854

11 and a “braking” mechanism (i.e., cup 26) which holds the ball **11** in a “fixed” position (relative to the other structure) that allows the marking device **46** to mark the putting directional indicator on the dynamic axis.

With respect to claim 2, note the device of Beny et al. includes means for locating the dynamic axis of the ball (motor **20**, shaft **28**, batteries **32**, etc.).

With respect to claims 3-5 and 24-26, note Beny et al. teach a decorative mark or symbol (i.e., a single dot) for marking the dynamic axis in column 4, lines 26-32 and lines 42-46 of Beny et al.

With respect to claim 6, to the extent the claim recites any additional structural limitation, note the ball of Beny et al. is capable of not being marked prior to marking by the marking device and therefore Beny et al. meets the claim language as recited.

With respect to claim 7, note the marking device and braking mechanism of Beny et al. can broadly be considered to be separate and non-integral devices.

With respect to claim 8, note column 4, lines 40-42 of Beny et al.

With respect to claim 19, note Beny et al. teach an automated method as recited, particularly in column 4, lines 36-42. Note the braking mechanism (i.e., cup **26**) broadly holds the position of the ball “fixed” so that the dynamic axis is at a specific location relative to the other structure.

With respect to claim 23, note Beny et al. teach the concept of mass processing of golf balls in column 4, lines 33-42.

4. Claims 1-2 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Movick (US 4,860,578). Movick teaches a ball marking device comprising a marking device (column 3, lines 21-24) for marking a putting directional indicator on the dynamic axis of the ball and a “braking” mechanism (i.e., cup 4) which holds the ball in a position that allows the marking device to mark the putting directional indicator on the dynamic axis.

With respect to claim 2, note Movick includes a means for locating the dynamic axis.

With respect to claim 6, to the extent the claim recites any additional structural limitation, note the ball of Movick is capable of not being marked prior to marking by the marking device and therefore Movick meets the claim language as recited.

With respect to claim 7, note the marking device and braking mechanism of Movick can broadly be considered to be separate and non-integral devices.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-5, 8, 19, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Movick in view of Beny et al. Movick teaches a marking device as recited with the exception of the putting directional indicator being other than a circumferential line. Beny et al. teach a marking device for marking a golf ball including putting an indicator on the ball other than a circumferential line. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a mark other than a circumferential line as taught by Beny et al. in the device of Movick as it would simply require obvious design choice of the particular indicia or marks to be printed on a golf ball.

With respect to claim 8, note that although Movick is silent with respect to what type of marking means is used to mark the golf ball, Beny et al. teach the use of a laser marking apparatus to mark a golf ball is well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a laser marking system as taught by Beny et al. in the device of Movick, as it would simply require the obvious substitution of one known marking device for another to provide clear marking of indicia on the surface of the golf ball.

Art Unit: 2854

With respect to claims 19 and 23, again although Movick is not clear as to whether the locating of the axis, holding of the ball, and marking of the ball are automated steps, Beny et al. teach mass processing of golf balls is well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to automate the process of Movick to perform the steps on multiple balls to allow for mass production of the marked golf balls.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
July 20, 2004